

REMARKS

Claims 1 and 2-41 are active in the present application.

At the outset, Applicants wish to thank the Examiner for the indication that the previous claim objection, indefiniteness rejection, enablement rejection, and anticipation rejections over Matsueda et al, Etzkorn et al, and Saika et al (Claim 2 only) have been withdrawn. Reconsideration of the remaining rejection over Saika et al is requested.

The rejection of Claims 1, 4, 8-11 and 16-19 under 35 U.S.C. §102(b) over Saika et al is obviated by amendment.

The Examiner has maintained that Example 21, page 50, of Saika et al discloses a compound within the scope of the claimed invention (i.e., formula (1)). It is the Examiner's position that the compound of Example 21, N-(2-naphthoyl)-N-methyl-D-phenylalanyl-L-tryptophan, meets the structural criteria of the claimed peptide because when n is 0 2-naphthyl-C(=O) is 2-naphthyl. Accordingly, the compound of Example 21, (N-(2-naphthoyl)-N-methyl-(D)-phenylalanyl-(L)-tryptophan), has the following substituents described in the context of formula (1):

| | | | |
|----------------|----------------------------|-----------------|-------------------------|
| Ar | Unsubstituted naphthyl | X ³ | NR ¹⁰ |
| n | 0 | R ¹⁰ | H |
| R ² | CH ₃ | m | 1 |
| R ³ | H | R ⁷ | L-tryptophan side chain |
| R ⁴ | D-phenylalanine side chain | R ⁸ | H |
| X ² | Single bond | X ⁴ | O |
| R ⁵ | Formula (2) | R ⁹ | H |

Applicants note that this compound is distinct from the claimed peptide in that Claim 1 defines the class of claimed peptides where n is 0 and does not claim tryptophan as an alternative at the R⁷ position. Moreover, at no point does Saika et al disclose or suggest a peptide within the scope of the claimed invention where n is 1 (see Claim 24).

The standard for determining anticipation requires that the reference “must teach every element of the claim” (MPEP §2131). Therefore, the failure of Saika et al to specifically disclose or suggest a peptide within the scope of the claimed invention would necessarily make this reference fail to anticipate the claimed invention.

Withdrawal of this ground of rejection is requested.

Applicants wish to further note that Etzkorn et al does not affect the patentability of the currently claimed invention, even in view of the removal of the previously inserted proviso, for the following reason.

Etzkorn et al was cited by the Examiner as disclosing a single compound within the scope of the originally claimed invention (compound 17 appearing on page 10416). Compound 17 disclosed by Etzkorn et al have the following substituents described in the context of formula (1):

| | | | |
|----------------|--------------------------------|-----------------|---------------------|
| Ar | Unsubstituted naphthyl | X ² | Single bond |
| X ¹ | CH ₂ | X ³ | NR ¹⁰ |
| n | 1 | R ¹⁰ | H |
| R ¹ | H | m | 1 |
| R ⁶ | NHY | R ⁷ | Tyrosine side chain |
| Y | Acetyl | R ⁸ | H |
| R ² | H | X ⁴ | O |
| R ³ | H | R ⁹ | CH ₃ |
| R ⁴ | C ₃ -guanidinoalkyl | | |

Applicants note that this compound is distinct from the claimed peptide in that Claim 24 defines the class of claimed peptides where n is 1 and does not claim tyrosine as an alternative at the R⁷ position. Moreover, at no point does Etzkorn et al disclose or suggest a peptide within the scope of the claimed invention where n is 0 (see Claim 1).

The standard for determining anticipation requires that the reference “must teach every element of the claim” (MPEP §2131). Therefore, the absence of any disclosure by Etzkorn et al of a compound within the scope of formula (1), would necessarily make this reference fail to anticipate the present invention and, thus, fail to effect the patentability of the claimed invention.-

The rejection of Claims 1-19 under 35 U.S.C. §112, second paragraph, is obviated by amendment.

The Examiner has rejected Claims 1-19 asserting that the limitation “X² Absent” lacks sufficient antecedent basis. Applicants have deleted this text from the claim and, therefore, this ground of rejection is no longer believed to be tenable.

In view of the foregoing comments and the amendments presented herein, Applicants request withdrawal of this ground of rejection.

The objection to the amendment filed on January 26, 2004 as introducing new matter and the rejection of Claims 1, 24, and 4-19 under 35 U.S.C. §112, first paragraph (written description) are obviated by amendment.

The Examiner has objected to the introduction of the proviso as introducing new matter and/or not being described in the specification as filed. Although Applicants do not

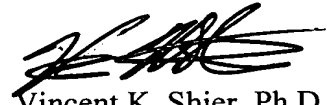
acquiesce to this assertion by the Examiner, Applicants note that Claim 1 has been amended to remove the proviso and as such this objection and rejection are no longer applicable.

Withdrawal of this ground of objection and the written description rejection is requested.

Applicants submit that the present application is now in condition for allowance.
Early notification of such action is earnestly solicited.

Respectfully submitted,

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(OSMMN 08/03)

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